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BANNER & WITCOFF LTD.,  
ATTORNEYS FOR MICROSOFT  
1001 G STREET, N.W.  
ELEVENTH STREET  
WASHINGTON, DC 20001-4597

EXAMINER

AWAD, AMR A

ART UNIT PAPER NUMBER

2675

DATE MAILED: 01/14/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/750,288

Applicant(s)

KEELY ET AL.

Examiner

Amr Awad

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8, 9, 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The references cited in the information disclosure statements filed November 18, 21 and 25, 2003 have been considered by the Examiner; see attached PTO-1449.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites "maintained despite re-flowing of said displayed information by a layout engine". This limitation is not clear because the term despite makes it not clear whether the re-flowing is carried out or not.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 2, 7, 8 and 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Morishita et al. (US patent NO. 6,335,727; hereinafter referred to as Morishita).

As to independent claim 2, Morishita (figures 44A, 44B and 44C) teaches a computer-implemented method for adding electronic ink to displayed information on a system having a display (col. 3, lines 61-67). Morishita teaches classifying the electronic ink (the classifying of the electronic ink is the classifying of first and second mode as shown in figures 44A and 44B) (col. 25, lines 27-41). Morishita teaches associating the electronic ink with at least one object of the displayed information (the association of the electronic ink with at least one object on the display is the searching a written image in a region enclosed within a closed curve as shown in figures 44A and 44B) (col. 25, lines 41-57). Morishita teaches that the electronic ink is embedded ink (col. 30, line 64 through col. 31, line 10).

As to claim 7, Morishita (figures 44A, 44B and 44C) teaches a computer-implemented method for adding electronic ink to displayed information on a system having a display (col. 3, lines 61-67). Morishita teaches classifying the electronic ink (the classifying of the electronic ink is the classifying of first and second mode as shown in figures 44A and 44B) (col. 25, lines 27-41). Morishita teaches associating the electronic ink with at least one object of the displayed information (the association of the electronic ink with at least one object on the display is the searching a written image in a region enclosed within a closed curve as shown in figures 44A and 44B) (col. 25, lines

41-57). As can be seen above, the closed curve is near the search region, which is similar to the limitation of claim 7 (col. 25, lines 41-58).

As to claim 8, Morishita (figures 44A, 44B and 44C) teaches a computer-implemented method for adding electronic ink to displayed information on a system having a display (col. 3, lines 61-67). Morishita teaches classifying the electronic ink (the classifying of the electronic ink is the classifying of first and second mode as shown in figures 44A and 44B) (col. 25, lines 27-41). Morishita teaches associating the electronic ink with at least one object of the displayed information (the association of the electronic ink with at least one object on the display is the searching a written image in a region enclosed within a closed curve as shown in figures 44A and 44B) (col. 25, lines 41-57). Morishita teaches that the electronic ink is embedded ink (col. 30, line 64 through col. 31, line 10). As best understood by the examiner, Morishita (figures 44A and 44B) shows that the electronic ink (the dashed line by the pen) is maintained despite having other information (re-flowing).

As to claims 27-28, the claims are also similar to claim 2 and are rejected as applied to claim 2 above.

As to claim 29, the claim is broad enough that the handwriting shown for example in figure 36 is an in-flow of at least one object.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2675

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-6, 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxted (US patent NO. 6,340,967).

As to claim 1, Morishita (figures 44A, 44B and 44C) teaches a computer-implemented method for adding electronic ink to displayed information on a system having a display (col. 3, lines 61-67). Morishita teaches classifying the electronic ink (the classifying of the electronic ink is the classifying of first and second mode as shown in figures 44A and 44B) (col. 25, lines 27-41). Morishita teaches associating the electronic ink with at least one object of the displayed information (the association of the electronic ink with at least one object on the display is the searching a written image in a region enclosed within a closed curve as shown in figures 44A and 44B) (col. 25, lines 41-57).

Morishita does not expressly teach that the classifying of the electronic ink is based on a shape of the electronic ink.

However, Maxted teaches a pen based edit correction interface, wherein the user simply writes or prints on an active surface of a digitizer and the ordered set of strokes displayed on the computer screen as Electronic Ink (col. 11, lines 10-18). As can be seen for example, in figures 8A and 8B of Maxted's device that the shape of the stroke (shape of the electronic ink) affects the mode of the display (i.e., classifying of the electronic ink) (col. 7, lines 59-65).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Maxted having the shape of the electronic ink affects the classifying of the electronic ink, to be incorporated to Morishita's device so as motivated by Maxted, to reduce the number of symbols used in an electronic ink device by changing the mode (i.e., the classifying of the ink) based on the shape of the electronic ink (col. 2, lines 63-67).

As to claim 3, the claim is broad enough that the width determination of the recorded writing pattern and displayed writing pattern is indicative of determining the distance (col. 24, lines 41-65).

As to claim 4, as discussed above with respect to claim 3, the width determination of the recorded writing pattern and displayed writing pattern is indicative of the ratio of its height to width (col. 24, lines 41-65).

As to claim 5, Morishita teaches anchoring the electronic ink to at least one object (the object would be the circled written image in figure 44A) by adding a link to the displayed information (the link would be linking to a search region) (col. 25, lines 45-48).

As to claim 6, the closed curve (electronic ink) in figures 44A and 44B for search region is indicative of anchoring the electronic ink to a file position because the search is carried out by searching the memory (col. 25, lines 59-67).

As to claims 14-19, the claims are referring to a computer readable medium, which implements the method of claims 1, 3-6, and as can be seen from Morishita's invention, the device is carried out by a computer readable medium (this is apparent

from the flowcharts throughout the drawings of Morishita). Therefore, the rejections of claims 1-8 are equally applied to claims 14-19.

As to claim 20, as can be seen above, the closed curve is near the search region, which is similar to the limitation of claim 7 (col. 25, lines 41-58).

As to claim 21, as best understood by the examiner, Morishita (figures 44A and 44B) shows that the electronic ink (the dashed line by the pen) is maintained despite having other information (re-flowing).

8. Claims 9-13 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morishita and Maxted in view of Wilcox et al. (US patent NO. 5,889,523; hereinafter referred to as Wilcox).

As to claims 9-13, note the discussion of Morishita and Maxted above. As can be seen above, Morishita and Maxted teach all the limitations of claims 9-13 except the citations of classifying the ink as in-line words, text marks, in-line paragraphs and sketches, margin notes or as a connector.

However, Wilcox (figures 3 and 8-9) teaches a method of entering and editing text in a graphic system (col. 2, lines 16-19). Wilcox shows that the ink used is classified as in-line word, text marks, in-line paragraphs, margin notes or a connector (see figures 3, 8-9, col. 2, lines 16-19, col. 4, line 53 through col. 5, line 11, col. 10, lines 25-33 and col. 11, lines 23-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Wilcox as indicated above to



incorporated to Morishita's device because such classifications of the ink is necessary for manipulating and editing a document in handwriting forms as it is necessary in managing and editing a conventional word files to facilitate and ease the work of the user. Furthermore, as motivated by Wilcox, to provide an accurate selection technique for graphical editing (col. 2, lines 20-23).

As to claims 22-26, the claims are substantially similar to claims 9-13 and would be rejected as discussed with respect to the rejections of claims 9-13 above.

9. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morishita and Maxted in view of Huang (US patent NO. 6,384,815).

As can be seen above Morishita (figure 36) shows a chain of strokes. Morishita does not teach associating a center of the chain of strokes with at least one object.

However, Huang teaches an automatic highlighting tool for document composing and editing (title). Huang teaches a conformation process, which may also center individual highlighting, strokes on their associated text line (col. 5, lines 2-10).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teaching of Huang to be incorporated to Morishita's device so as motivated by Huang, to be able to have the device adapt to particular user's writing style (col. 2, lines 14-17).

***Response to Arguments***

10. Applicant's arguments filed 10/09/2003 have been fully considered but they are not persuasive.

Applicant (page 7) argued that Morishita does not classify electronic ink, but merely designates a search region within electronic ink, and that Morishita does not classify electronic ink based on a shape of an ink strokes. Examiner respectfully disagrees. In examining the claims on the merit; examiner is using the broadest reasonable interpretation of such claims. By doing that, the term "classifying electronic ink" is merely equivalent to identifying that the electronic ink can be used in different modes. As described above, Morishita shows that the electronic ink (i.e., the writing using the writing device) can be used for entering handwriting, or erasing mode. Therefore, when the device is used for handwriting, the electronic ink is classified as ink for writing, and when the device is used for erasing, the electronic ink is classified as erasing ink. As to the newly added limitation that classifying electronic ink is based on a shape of an ink stroke; the rejection is now includes Maxted which teaches the newly added limitation.

Applicant (top of page 8) argued that Morishita does not teach associating electronic ink with at least one object of the displayed information. Examiner respectfully submits that having a closed curve (which is carried out by the electronic ink) and associating (i.e., searching) the enclosed object, fairly reads on the claimed limitation. With respect to the argument of claim 3, it is clear from figure 5; Morishita shows the

position information holding section (26), which clearly shows that the distance is being determined. Similar argument is applied to claim 4.

Applicant (page 9) argued with respect to claim 2 that Morishita does not teach that the classifying step classifies the electronic ink embedded ink and overlaid ink. Examiner respectfully disagrees. Examiner has cited col. 30, line 64 through col. 31 line 10) which clearly shows using a special ink embedded in the information writing section and overlaid ink, which is shown in figure 31B which shows closed loop over the writing (i.e., overlaid). Examiner firmly believes that the claim is broad enough to read on the cited reference.

Applicant (page 10) argued that Morishita does not teach that the associating step further includes the step of: anchoring said electronic ink to said at least one object by adding a link at or near said object pointing to said electronic ink. Examiner respectfully disagrees. This limitation simply means circling (anchoring) an object with the electronic ink which clearly shown in figure 31B.

As to claim 8, the claim still not clear to the examiner, and as best understood by the examiner, claim 31B broadly teaches the claimed limitation.

With respect to the arguments of claims 9-28, these arguments for these claims is substantially similar to the argument presented with respect to claims 1-8 and the response is substantially similar to the response presented above.

***Conclusion.***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amr Awad whose telephone number is (703)308-8485. The examiner can normally be reached on Monday-Friday, between 9:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Saras can be reached on (703)305-9720. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9314 for regular communications and (703)872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4750.



A.A  
January 10, 2004.